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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,684	04/24/2006	Gunter Fuhr	1180/20046	1351
3000 7590 11/20/2007 CAESAR, RIVISE, BERNSTEIN, COHEN & POKOTILOV, LTD. 11TH FLOOR, SEVEN PENN CENTER 1635 MARKET STREET PHILADELPHIA, PA 19103-2212			EXAMINER ROGERS, DAVID A	
			ART UNIT 2856	PAPER NUMBER
			NOTIFICATION DATE 11/20/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@crbcp.com

Office Action Summary

Application No.

10/561,684

Applicant(s)

FUHR ET AL.

Examiner

David A. Rogers

Art Unit

2856

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-10, 12-15 and 18-23 is/are rejected.
- 7) ☒ Claim(s) 6, 11, 16 and 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 5/25/2006.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to because the word "Figur" should be corrected to "Figure". With regard to figure 7 the phrase "Stand der Technik" should be replaced with "Prior Art". Corrected drawing sheets in compliance with 37 C.F.R. 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended."
2. If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 C.F.R. 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 U.S.C. § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 23 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 23 recites the step of "coiling-up a compound comprising of sample chambers and holding frames". It is not clear how the applicant intends to coil-up a compound that includes sample chambers and holding frames.

Claim Rejections - 35 U.S.C. § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, 4, 7, 8, and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent 3,993,816 to Baudet *et al.*

With regard to claim 1 the phrase "for cyroconservation of at least one sample" is not being afforded any patentable weight as this phrase does not structurally distinguish the claims over the prior art.

Baudet *et al.* discloses a receiving device comprising a plurality of hose-shaped chambers (reference item 2) joined in a holding device. The holding device is shown as comprising frames (reference item 1) having frame parts. In at least figures 1, 2, 4, 6-9 the hose-shaped members are provided in a self-supporting arrangement. In at least figures 14 and 15 the receiving device has a plurality of frames.

With regard to claims 2 and 3 the frames are shown as being generally planar and rectangular.

With regard to claim 4 one can see in figure 13 "distances" between the frames when viewing either the gaps adjacent the tabs (reference item 4) or the gap between alternating frames.

With regard to claim 7 one can see a stack of frames in figures 14 and 15.

With regard to claim 8 one can see in figure 16 a stack of frames held together by a collar (reference item 17) which, therefore, functions as a bracket.

With regard to claim 18 one can see in figure 13 that the sample chambers (hose-shaped members) are provided on frames in the longitudinal direction of the frames.

With regard to claim 19 one can see in figure 13 that the sample chambers are provided by uncoiling delivering rollers (reference item 9).

With regard to claim 20 the sample chambers are drawn from their respective delivery rollers simultaneously.

Claim Rejections - 35 U.S.C. § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-5, 7-10, 12-15, 18-20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over International Patent Application Publication WO 2002/46719¹ to Fuhr *et al.* in view of Baudet *et al.*

Fuhr *et al.* teaches that it is known to provide a plurality of flexible, hose-shaped sample chambers in a holding device. As seen in figure 2 the holding device is a frame (reference item 627) having frame elements that form a rectangle. The device also comprises an integrated data storage unit (reference item 622). Fuhr *et al.* does not teach a plurality of holding frames.

Baudet *et al.* teaches a sample receiving device comprising a plurality of hose-shaped chambers (reference item 2) joined in a holding device. The

¹ United States Patent 6,931,864 is the national stage patent that resulted from PCT EP01/14400. International Patent Application Publication WO 2002/46719 is a German-language publication of the PCT. United States Patent 6,931,864 is relied upon for translating the international patent application publication.

holding device is shown as comprising frames (reference item 1) having frame parts. In at least figures 1, 2, 4, 6-9 the hose-shaped members are provided in a self-supporting arrangement. In at least figures 14 and 15 the receiving device has a plurality of frames. The

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Fuhr *et al.* with the teachings of Baudet *et al.* in order to provide a plurality of frames as this is would expedite the manufacturing of multiple sample receiving devices.

With regard to claim 2 both Fuhr *et al.* and Baudet *et al.* teach that the frames are shown as being generally planar and rectangular.

With regard to claim 4 one can see in Baudet *et al.*'s figure 13 the presence of "distances" between the frames when viewing either the gaps adjacent the tabs (reference item 4) or the gap between alternating frames.

With regard to claim 5 the applicant's choice of a preferred distance dimension is an obvious modification to the device of Baudet *et al.* and does not patently distinguish over the prior art. See also MPEP §2144.04:

In Gardner v. TEC Systems, Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

With regard to claim 7 one can see a stack of frames in Baudet *et al.*'s figures 14 and 15.

With regard to claim 8 one can see in Baudet *et al.*'s figure 16 a stack of frames held together by a collar (reference item 17) which, therefore, functions as a bracket. This is useful for transporting the stack of frames.

With regard to claim 10 it is considered obvious to provide each holding frame with an integrated data storage element so that each device can operate correctly for cryopreservation.

With regard to claim 12 Fuhr *et al.* also teaches that it is known to provide the sample chambers with rectangular cross-sections as seen in figures 9 and 10).

With regard to claim 13 the all of the sample chambers are formed in the frame such that a planar, lateral surface is formed that is parallel to plane of the holding frame.

With regard to claims 14 and 15 Fuhr *et al.* teaches that it is known to provide sample chambers whose cross-section varies along a length of the sample chamber as seen in figure 4 and figure 5.

With regard to claim 18 one can see in figure 13 that the sample chambers (hose-shaped members) are provided on frames in the longitudinal direction of the frames.

With regard to claim 19 one can see in figure 13 that the sample chambers are provided by uncoiling delivering rollers (reference item 9).

With regard to claim 20 the sample chambers are drawn from their respective delivery rollers simultaneously.

With regard to claim 22 Fuhr *et al.* teaches that the frames and sample chambers are attached via an injection molding process.

9. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fuhr *et al.* and Baudet *et al.* as applied to claim 18 above, and further in view of United States Patent 3,551,951 to Schiesser.

Fuhr *et al.* teaches the use of sample chambers formed as flexible members. Fuhr *et al.* does not teach forming the sample chambers by parallel extrusion.

Schiesser teaches that it is known to simultaneously extrude multiple flexible tubes. See column 1 (lines 27-29).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Fuhr *et al.* and Baudet *et al.* with the teachings of Schiesser in order to form the tubes by simultaneous extrusion in order to increase the speed at which the tubes are formed.

Allowable Subject Matter

10. Claims 6, 11, 16, and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Rogers whose telephone number is (571) 272-2205. The examiner can normally be reached on Monday - Friday (0730 - 1600). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron E. Williams can be reached on (571) 272-2208. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David Rogers/
Examiner - Group Art Unit 2856